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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1950

No. 32

THE GREAT ATLANTIC & PACIFIC TEA COMPANY,
Petitioner,

vs.

SUPERMARKET EQUIPMENT CORPORATION,
Substituted for EVELYN B. BRADLEY
and JOE WEINGARTEN,
Respondent.

BRIEF FOR RESPONDENT ON WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE SIXTH CIRCUIT

TOWNSEND F. BEAMAN,
Attorney for Respondent.
Business Address:
Reynolds Building
Jackson, Michigan.

LLOYD W. PATCH,
Of Counsel.

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SUMMARY OF ARGUMENT

Invention of the Turnham patent 2,242,408 in suit was the first to provide any appreciable reduction in the waiting time at the checkout counter of self-serve food stores.

Customer's annoyance at waiting in line had always been a problem of self-serve food stores. The problem arose with the introduction of the first self-serve store in 1917, the first time two customers approached the checkout counter at approximately the same time. It remains a mitigated problem today. Turnham's invention has reduced the waiting time by approximately thirty per cent.

From 1917 to 1937 the practice of waiting on customers at the checkout counters of self-serve food stores remained practically the same. The customer selected his merchandise, carried it to the checkout counter and waited for the cashier to check the merchandise from the basket and to sack the same. Although the waiting line may have become longer in the middle thirties, the waiting time between adjacent customers in line remained the same. No suggestion was forthcoming which mitigated the problem until Turnham conceived a modification of the L-counter in combination with a self-unloading pusher or slide in the form of a three-sided framework which permitted preparation of the merchandise for more rapid handling by the cashier or checker.

The Turnham invention was promptly placed in full scale use in the Weingarten Markets of Houston, Texas. There, competition was quick to observe and adopt it. The knowledge of the invention spread rapidly throughout the United States among the experts in the field of self-serve food markets. These experts were prompt in appreciating the merits of the invention and to equip their own stores with it. The United States Department of Commerce, in its publication "Domestic Commerce", recommended the Turnham invention to food market operators as a means to reduce the delay at the checkout counter.

Unassisted by advertising and high-pressure selling, the Turnham invention was widely adopted by the self-serve food markets within a period of a few years after it was placed in use in the Weingarten markets.

By reducing the waiting time at the checkout counter by thirty per cent or more during rush periods, substan-

tial savings to food market operators have been realized in the cost of equipment, space and personnel. Use of the Turnham invention has been made available to the food market industry upon a nominal royalty basis. There is no contention of improper use of patent rights.

Turnham's patent comes before this court with an impressive record. In the United States Patent Office the best prior art was cited. The District Court found facts, concurred in by the majority of the Court of Appeals, which established validity and infringement under established principles of law.

The patented invention appears simple but it easily passes the difficult test of patentable inventions. Simplicity has never defeated an invention which solved or mitigated a problem of long standing in an unobvious manner. The commercial success of the Turnham invention, not measured by the usual standard of licenses granted or volume of sales but by its adoption by experts following disclosure, is convincing proof of its novelty and utility in the face of a long-felt want.

The stipulation before trial as to the petitioner's infringement of claims 4, 5 and 6, if valid, avoided any necessity, during trial, of establishing infringement of claims 4, 5 and 6. It was within the discretion of the District Court to permit respondent to withdraw the broad claims 1, 2 and 3 and rely entirely upon the more limited claims admitted to be infringed. The petitioner, having failed to plead a declaratory judgment counter-claim requesting an adjudication of invalidity of all the claims of the patent in suit, is not entitled to object to the ruling of the District Court permitting the amendment of the pleadings.

There is no basis for the petitioner's contention that the courts below based the finding of invention on a combination of elements not set forth in the claims in suit. Each of claims 4, 5 and 6, and especially claims 5 and 6, set forth the novel combination of a counter having a portion removed from the cashier's stand or position with a bottomless, self-unloading frame for moving the merchandise, unloaded on the portion of the counter removed from the cashier's stand, to a point adjacent thereto. The mere absence from Claims 4, 5 and 6 of the word "extension" used by the courts below in their findings of invention, with the presence of equivalent language, removes these claims from any such attack.

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

OPINIONS BELOW

The opinion of the District Court (R. 511) is reported in 78 Fed. Supp. 388. In the District Court claims 4, 5 and 6 of the Turnham patent in suit were held valid; infringement having been admitted by the petitioner. The Court of Appeals affirmed (R. 531) the District Court, with Judge Martin dissenting, the opinion being reported in 179 Fed. (2d), 636.

JURISDICTION

The Judgment of the Court of Appeals for the Sixth Circuit (R. 530) affirming the District Court, was

entered January 17, 1950. The Writ of Certiorari was granted May 1, 1950. The jurisdiction of this court was confirmed by C. 646 of the Act of June 25, 1948, 62 Stat. 928, 28 U. S. C. A. 1254.

QUESTIONS PRESENTED

(1) Are the elements of the combination found by the courts below to be novel and patentable set forth in claims 4, 5 and 6 of the Turnham patent?

(2) Does Turnham's contribution to the art of handling merchandise at the checkout counter of self-serve food markets pass the difficult test for patentable inventions?

(3) Did the Court of Appeals err in affirming the District Court's action in allowing respondent to withdraw broad claims 1, 2 and 3 of the patent in suit and rely upon more limited claims 4, 5 and 6, which were stipulated prior to the trial as being infringed by petitioner, if valid?

STATEMENT OF THE CASE

The original plaintiffs were Herbert N. Bradley of Jerome, Michigan, and Joe Weingarten of Houston, Texas. Bradley had been an employee of the petitioner for twenty years (R. 19) at the time of his death shortly after this suit was filed in 1945. He was the inventor of the Bradley Patent No. 2,317,438 (R. 301). Weingarten was the owner, by assignment, of the Turnham patent in suit and he had been operating self-serve grocery stores since 1919 (R. 84). The original plaintiffs and their successors in interest are engaged in the licensing of the inventions of the Turnham and Bradley patents (R. 292, 313).

The petitioner is charged with infringement within the jurisdiction of the United States District Court for the Eastern District of Michigan, Southern Division, of the Turnham patent, No. 2,242,408 issued on May 20, 1941, and maturing from an application filed October 28, 1938. The specific act of infringement, of which the respondent complains, was the provision of an extension to the standard form of counter then in use in petitioner's West Michigan Avenue store in Jackson, Michigan, and the association therewith of a guided, bottomless, self-unloading,

three-sided pusher or slide, all as shown in Plaintiff's Exhibits 14 and 15 (R. 24, 310A, 312A), which are pictures taken in the aforesaid store.

The charge of infringement is *not "based upon the use by the petitioner of a simple three-sided bottomless rack slidable on a checkout counter"* as alleged in the Petitioner's statement of the case. The practice of the Turnham invention involves the provision of *a counter of specific construction and the use in combination therewith of a merchandise handling device of specific construction and character.* Accordingly, the charge of infringement is based upon the use by petitioner of *an entirely new counter arrangement which necessitated the lengthening of the counter previously used to provide a portion upon which the groceries could be unloaded at a point removed from the place upon the counter previously used for that purpose, in combination with the specific device used on the lengthened counter for moving and unloading the merchandise.*

When the petitioner first started to practice the use of the Turnham invention, the extension to the standard counter was a make-shift addition, as shown in the photograph, plaintiff's Exhibit 14 (R. 310A). Later the principle of construction of the Turnham invention was made an integral part of petitioner's counter construction (R. 32) in the manner shown in Figs. 1 and of the drawings of the Turnham patent in suit.

Infringement of Claims 4, 5 and 6 Admitted by Stipulation Before Trial.

In the complaint, the petitioner was charged with the infringement of the Turnham patent without mention of any specific claims thereof. Prior to the trial, by stipulation between counsel, petitioner admitted that claims 4, 5 and 6 would be infringed, if valid. A portion of this stipulation was read into the record by the District Court (R. 6).

Prior to trial there was no interrogation of respondent by petitioner as to the claims which would be relied upon at the time of trial. At the trial respondent advised the court that it was relying upon claims 4, 5 and 6 (R. 186-7).

The Turnham Patent.

The Turnham patent No. 2,242,498 (R. 318) was applied for on October 28, 1938, and was issued May 20, 1941. That it pertains to a simple mechanical structure is readily apparent from the drawings of the patent wherein an elongated counter 2 is shown having a top 3. On page 1, column 2, commencing with line 48 of the patent, that portion of the top 3 which extends to the left of the cash register 6 is designated as an extension 15. It is upon this extension 15 that the customer places his groceries within the pusher or slide provided by the framework 20 while the customer ahead is being waited upon at the area designated by reference 12.

It was found by the courts below that the Turnham invention resided in the new combination of a counter having an extension 15 upon which the groceries were unloaded while the customer ahead was being waited upon, with a three-sided, self-unloading, bottomless framework 20 which was actuated to slide the groceries along the surface of the counter from a point remote from the cashier's stand to a place adjacent thereto. Thereafter the framework 20 is moved back for use by the following customer during the time the groceries just moved into the area 12 are being checked. By this simple arrangement of the counter construction and merchandise handler, capable of being adapted to standard counters by a carpenter overnight, as will appear from plaintiff's Exhibits 14 and 15 (R. 310A, 312A), over thirty per cent more customers could be waited upon during the same period of time (R. 55, 77). In the record below there is no contradiction of this claimed increase in efficiency brought about by the Turnham invention over the prior practice.

In adopting the Turnham invention, the self-serve food market operators have utilized the essence of the invention. While it is true that there has been some slight modification of the construction shown in the Turnham patent, there has been no departure from the inventive concept. Moreover, these modifications were made by the inventor Turnham in the Weingarten Markets and did not stem from any contribution made by the petitioner.

In the Turnham patent (at page 1, column 2, line 54) it is stated that the articles 17 are placed upon the extension

15 by *either* the customer or the pusher boy. On page 2, column 1, line 33, it states that the handle 24 at the rear of the framework 20 (also referred to in the record below as slide, pusher and rack) may be grasped by the pusher boy or the frame may be grasped directly. Some manual manipulation of the framework 20 is necessary. Whether this manual manipulation is by either the customer or the pusher boy, as in the case of the placement of the articles 17 upon the extension 15, is within the contemplation of the Turnham patent. Moreover, providing a handle on the framework 20 where it may be grasped by the cashier or checker is, likewise, clearly within the scope and contemplation of the Turnham invention and claims 4, 5 and 6 of the patent.

Problem of Delay at the Checkout Counter was of Long Standing.

Prior to the introduction by Clarence Saunders of the Piggly Wiggly self-serve grocery stores in 1917, the merchandise was handled by the counter clerk as ordered by the customer from across the counter. Until a clerk was available, the customer could do little toward assisting in removing the merchandise from the store shelf into the possession of the customer. Saunders' self-serve store permitted, for the first time, a great deal of self-help on the part of the customer. The customer selected his merchandise, carried it to the counter and the clerk removed it from the basket, arranged it and checked it out. However, while the clerk was waiting on one customer the next customer in line could do nothing to further expedite his exit from the store except to wait his turn. Back in 1917 in a small self-serve Piggly Wiggly store with one counter and one checkout clerk, the need for and the advantages of the Turnham invention were the same as they exist today in the so-called self-serve "Supermarket" many times larger and with numerous counters and checkout clerks.

There is no factual basis for petitioner's contention that the problem, mitigated by the Turnham invention, dates from the advertisers' catch word "Supermarket" as ap-

plied to large self-serve food markets. The size of the store has nothing to do with the utility of the Turnham invention. The problem of delay in the checking out of the customer past the counter was just as acute in a small store with five customers and one checkout clerk as in a large store with fifty customers and ten checkout clerks.

If largeness is to be the criterion, Weingarten's No. 1 self-serve store in 1919 occupied 7500 sq. ft. (R. 85). The Weingarten No. 7 self-serve store was constructed in 1928-29 and occupied 20,000 sq. ft. (R. 86). The witness Buchoz dates the small type self-serve markets from 1923 (R. 120) with the self-serve "Supermarket" operation in Detroit, Michigan, dating from 1932 (R. 119).

It is unreasonable for the petitioner to contend, in the light of the record below, that the problem which confronted Turnham in 1937 was a new problem which came into being with the catch word "supermarket". The line at the counter may have been longer in 1937 than at any previous time but the problem was an old one, dating from the first self-serve market in 1917.

Prior to Turnham's invention, the only solution employed to reduce the line-up at the counter was the installation of additional checkout counters (R. 53, 77). This required the use of valuable floor space within the store, the purchase of additional, expensive equipment, including additional cash registers, and added clerks. By the simple conversion of existing counters to the Turnham invention over thirty per cent more business could be handled without increasing the number of counters in the store.

Commercial Success of the Turnham Invention.

The District Court found that "practically every chain self-serve store organization in the country uses the device first installed in plaintiff's stores" (R. 514-15). This situation did not result from advertising or high-pressure salesmanship. The existing L-counters were modified and the merchandise handlers fabricated and installed by the maintenance crews of the chain store organizations (R. 24). Witnesses testified that both petitioner and the [illegible] Baking Company, two of the largest

chain store operators in the United States, attempted to develop checkout counters capable of moving people through the checkout at a more rapid pace at a time *subsequent* to the installation of the Turnham invention in the Weingarten Markets at Houson, Texas. In the end it was the Turnham invention which was generally installed in lieu of any other form (R. 30, 196).

It is true that the record below, with respect to recognition of respondent's patent rights through acceptance of licenses prior to the date of trial, is unimpressive. The District Court, in its decision, contributed this situation to a "wait and see" policy (R. 516) adopted after this suit for infringement was filed against the giant of the industry in 1945.

That the Turnham invention gained the approval of experts in the trade is not contradicted. It was featured in the trade magazines (R. 286A, 290A). The publication "Domestic Commerce" widely circulated by the United States Department of Commerce recommended its adoption (R. 326C) as a solution to the checkout problem.

Claims 4, 5 and 6 set Forth the Combination Found to be Novel and Patentable by the Lower Courts.

The District Court, in its opinion (R. 515) stated with reference to the new combination:

> "However, the extension to the checking-out counter was apparently something new, as it automatically placed the register farther up on the checking out aisle; and the use of the bottomless tray on that extension, self-unloading its contents right in front of the cashier, was decidedly a novel feature."

The majority opinion of the Court of Appeals quoted, with approval, the District Court's findings of fact 15 (R. 533, 534):

> "'15. Claims 4, 5 and 6 of the patent in suit define a new combination of elements brought together for the first time by Turnham to provide an improved check-out counter.

"'Three-sided bottomless racks or trays had been used in racking pool balls prior to the Turnham invention. Also checking-out counters were known. Moreover, guide rails for trays had been used in self-serve restaurants.

"'However, the conception of a counter with an extension to receive a bottomless self-unloading tray with which to push the contents of the tray in front of the cashier was a decidedly novel feature and constitutes a new and useful combination.'"

ARGUMENT

1. All the Elements of the Combination Found by the Courts Below to be New are set Forth in Claims 4, 5 and 6 of the Turnham Patent.

The petitioner's contention that the "extension" to Turnham's checkout counter forms no part of claims 4, 5 and 6 does not appear in the record below. *This contention was advanced for the first time in a petition for rehearing before the Court of Appeals, which was denied.*

This grasping at straws stems from the belated observation that the word "extension", as such, does not appear in claims 4, 5 and 6. In the Turnham patent, the counter is shown with a continuous top designated as top portions 3 and 16. That *portion* of the top of the counter to the left of the area 12, as shown in Fig. 1 of the drawings, is designated in the description of the patent as an "extension" (R. 320, column 2, line 49) having a top 16 upon which the various articles 17 are deposited by either the customer or the pusher boy.

In each of claims 4, 5 and 6 that *portion* of the counter which is referred to in the description of the Turnham

pliance with R. S. 4888.* To define the new combination it was necessary to designate the construction and location of the elements of the combination relative to the area 12 at which point the customer had placed his basket prior to the introduction of the Turnhara invention (R. 320, column 2, lines 35-41).

Of the three claims 4, 5 and 6 (stipulated by the petitioner to be infringed, if valid), claim 4 describes the "extension" in the new combination in the broadest terms. If the petitioner is to find any conceivable support for its contention that the "extension" is not set forth in claims 4, 5 and 6, it must confine itself to claim 4, which reads as follows:

> "4. A checker's stand including A COUNTER OF THE CHARACTER DESCRIBED, an open bottom pusher frame thereon, means to guide said frame in sliding movement so that goods placed ON THE END of said counter within said frame may be pushed along the counter in a group to a position adjacent the checker by movement of said frame." (Emphasis added).

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*Foot Note.

*R. S. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the

Claim 4 appears substantially in the form suggested by the patent Examiner during the prosecution of the Turnham patent before the United States Patent Office in the Official Action of November 14, 1939, wherein the Examiner states (R. 354-5): "It is thought that a claim describing the frame as bottomless and open at one side and combined with one end of a counter for sliding movement may be allowed."

Claim 4 calls for *a counter of the character described* in the specification which is a counter having a portion 15 at one end to receive the pusher frame with "*means to guide said frame in sliding movement so the goods placed on the end of said counter within said frame may be pushed along the counter in a group to a position adjacent the checker, by movement of said frame*". It is submitted that claim 4 broadly covers the combination considered novel and patentable by the patent Examiner and confirmed by the courts below.

If it can be said that claim 4, because of its broad scope, gives some support to petitioner's contention that "the courts below based the findings of invention on a combination of elements not set forth in the claims in suit", the language of claims 5 and 6 completely dissipate any such contention:

> "5. A cashier's counter for cash and carry type of grocery comprising A PORTION SPACED FROM THE CASHIER'S STAND AND UPON WHICH THE MERCHANDISE MAY BE DEPOSITED AND ARRANGED, a bottomless three sided frame on SAID PORTION and within which the merchandise is deposited and arranged, means whereby said frame is movable on said counter from SAID PORTION to a position adjacent the cashier's stand so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier." (Emphasis added).
>
> "6. A cashier's counter for cash and carry type of grocery comprising A PORTION SPACED FROM THE CASHIER'S STAND AND UPON WHICH THE MERCHANDISE MAY BE DE-

POSITED AND ARRANGED, a bottomless frame on SAID PORTION and within which the merchandise is deposited and arranged, means whereby said frame is movable on said counter from SAID PORTION to a position adjacent the cashier's stand so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier, said frame being open at the end adjacent the cashier's stand and readily movable to be returned over SAID PORTION so as to receive the merchandise of another customer while the cashier is occupied with the previous group." (Emphasis added).

It is the *extension* as an element of the new combination which the petitioner contends is not present in claims 5 and 6 and which was, according to the petitioner, improperly read into these claims by the findings of the courts below.

Claim 5 defines the *extension* as a "portion" and calls for a "portion" (of the counter) spaced from the cashier's stand and upon which the merchandise may be deposited and arranged. The relationship between the "portion" and the other elements of the combination is clearly set forth and defined in claim 5 by pointing out that it is upon this "portion" that the three-sided bottomless frame is arranged, and it is upon this "portion" and within the three-sided bottomless frame that the merchandise is deposited. It is further set forth in claim 5 that the frame is movable on the counter from the "portion" to a position adjacent the cashier's stand.

Claim 6 is even more specific than claim 5 in setting forth the elements of the new combination. The *extension* claimed by the petitioner to be omitted from the combination of elements is defined as a "portion" spaced from the cashier's stand. Throughout the claim the relationship of this "portion" to the other elements of the new combination is set forth in clear and precise language. A pictorial application of claim 6 to the petitioner's infringing counter, corresponding to Plaintiff's Exhibit 25 (R. 374A) and the photographs Exhibit 14 and 15 (R. 310A, 312A) is found in the appendix to this brief.

Petitioner's allegation that Circuit Judge Martin recognized, in his dissenting opinion, that the *extension* of the counter is not set forth in claims 4, 5 and 6, is baseless. To support this contention the petitioner quotes the following portion of Circuit Judge Martin's dissenting opinion:

> "I am unable to find invention in the patent claims in suit. It seems to me that the combination of the admittedly old elements as disclosed in the claims does not rise to the dignity of invention and that the findings of fact of the District Court are clearly erroneous."

There is no mention, in the dissenting opinion, of the combination found to be new and patentable as *being incompletely set forth in the claims.* To the contrary, it appears that Judge Martin found the combination fully set forth in the claims but was not impressed with the new combination as constituting a patentable invention.

There is no necessity to expand the scope of claims 4, 5 and 6. There is no substantial difference between the petitioner's infringing device and that disclosed in the Turnham patent. The specification clearly defines the structure set forth in the claims. The specification can be used to limit but never to expand the claims. See *McClain vs. Ortmayer*, 141 U. S. 419, 424.

The case of *Faulkner vs. Gibbs*, 338 U. S. 267, 268, clearly supports respondent's contention as to the proper form of claims 4, 5 and 6, which cover a new combination:

> "In the instant case, the patent has been sustained because of the fact of combination rather than the novelty of any particular element."

2. Petitioner's Belated Contention that the Claims it Admits it Infringes do not Comply with R.S. 4888 is an Act of Desperation.

No phase of patent law is better settled than the obligation imposed upon a patentee that every element and limitation relied upon to establish the validity of a claim must be particularly pointed out and distinctively claimed.

Halliburton Oil Well Cementing Co. vs. Cranford P. Walker, 329 U. S. 1.

Claims 4, 5 and 6 of the patent in suit are defined in language which is clear and precise. Every element of the combination found to be new by the Patent Office experts and which was affirmed by the courts below, is set forth. The relationship between the "portion" of the counter which constitutes the *extension* and described in the patent and referred to in the opinions below, is well defined with respect to the structure and function of the combination of elements. The decisions cited by the petitioner, while being sound in principle, have no application to these claims which particularly point out and distinctively claim the invention. There is no basis for the contention that claims 4, 5 and 6 define the structure of the new combination in "terms of what it will do rather than in terms of its own physical characteristics" as condemned in the Halliburton case.

3. Turnham's Contribution Passes the Difficult Test for Patentable Invention Set up by this Court.

With justification, this court has, in recent years, sought to raise the standard of invention. The impact of recent decisions by this court involving patent rights and their proper use is readily felt by those appearing before the United States Patent Office and the lower courts.

In raising the standard of invention, it has not been the purpose of this court to elevate the cloak of inventorship beyond the reach of man.

If this case is of importance, it is respectfully submitted that such importance resides in the opportunity afforded to this court to re-affirm some of the cardinal principles upon which our concept is based of granting to an inventor a limited monopoly.

Turnham made a simple invention. Reduced to its essential form it comprises only a counter portion ahead of the cashier's stand, a open-ended, three-sided, bottomless frame and guide structure for guiding the movement of the frame over the counter portion between the cashier's stand and the portion on the counter at which the customer unloads his groceries into the frame.

Such simplicity of structure is not always associated with an act of invention. That a patent was obtained upon such a simple structure, immediately raises, in the minds of many, a question of its validity. Only when viewed in the light of the long-felt want and the accomplishments of this simple structure can there be a full appreciation of the nature of Turnham's contribution to the art.

For at least twenty years customers in self-serve food stores had approached the checkout counter and impatiently waited in line to pay for their groceries. Store operators were keenly aware of the delay, and the impatience of their customers. Until Turnham had his *flash of genius* no one had ever come forward with a proposal to increase the efficiency of the checkout counter then in use.

It had never occurred to anyone prior to Turnham's conception and invention, that the addition of an *extension portion* to the counter and the use of a simple framework, which could be fabricated from three pieces of wood, would in effect result in an expansion of the capacity of the store to handle its customers during rush periods by more than thirty per cent.

With a device so simple that the customers in the store hardly appreciate its existence, or the opportunity of self-assistance it offers the customer in reducing the delay at the checkout counter, millions of food buyers throughout the United States are being saved an appreciable amount of annoyance and delay formerly experienced each time they enter a self-serve market. It is little wonder that the food market industry was quick to appreciate the merits of Turnham's invention and promptly adopted the same.

The food market operators, especially the petitioner, are in no position to speak of the Turnham invention in a disparaging manner. It offered a partial solution to their greatest problem and they were quick to seize upon it. Admidst the roar of acclaim and approval of the Turnham invention only the voice of Judge Martin speaks out against it in a dissenting opinion in which he finds that the new combination in the claims admittedly infringed by the petitioner "does not rise to the dignity of invention" (R. 537).

4. The Ray-O-Vac Case Supports Respondent's Position.

Shaken by a series of decisions by this court adverse to the patentee but designed to correct abuses and improper use of patent rights, the so-called Ray-O-Vac case, *Goodyear Tire & Rubber Co. vs. Ray-O-Vac Company*, U. S. S. C. (1944) 321 U. S. 275, was greeted with a great feeling of relief by patent owners and advocates of the basic principles of our patent system.

The amazing similarity between the *Ray-O-Vac* case and the case at bar prompted respondent to base its contention of validity of the Turnham patent upon the principles annunciated therein. If this case is to be distinguished from the *Ray-O-Vac* case, it must be with respect to facts which favor the patentee Turnham and strengthen the finding of invention by the courts below. To accentuate this similarity and give support to respondent's contention that the judgment of the District Court, affirmed by the Court of Appeals, should be sustained, the following parallel columns paraphrase the facts found by this court in the *Ray-O-Vac* case and by the courts below with respect to the Turnham patent:

Adjudication of the Patent

Ray-O-Vac	Turnham
Found valid and infringed by both the District Court and Court of Appeals with no conflict of decision.	Found valid and infringed by District Court and Court of Appeals with no conflict of decision other than a dissenting opinion in the Court of Appeals.

The Patent

Ray-O-Vac	Turnham
Related to a simple device taking the form of a leakproof dry cell for flashlight batteries.	Related to a simple device in the form of a merchandise handler used in combination with an extension on a checkout counter of self-serve stores.

The Problem

Ray-O-Vac

To overcome the expansion of the cell contents which causes bulging, breakage and seepage of the battery unit.

Turnham

To reduce the delay experienced by customers of self-serve food markets at the checkout counter.

Duration of the Problem

Ray-O-Vac

The tendency of dry cell batteries to damage flashlight containers by leaking, bulging and freezing in the container had long plagued the industry. So much so that most manufacturers attached warning notices to their flashlight batteries, advising users not to allow them to remain in the flashlight for extended periods of non-use and to remove a cell promptly upon ascertaining that it was dead.

Turnham

The problem of speeding up the flow of customers through a checking counter has plagued the food industry at least since 1920, and prior to 1937 the only known method of moving more customers through a given store in a given amount of time was to install more checking counters within that store, depriving the merchandising department of a certain amount of its valuable space. (Findings of Fact 8, R. 522-3).

The Prior Art

Ray-O-Vac

No patent in the prior art addressed itself to the problem of preventing both leakage and swelling in a dry cell.

Turnham

No patent in the prior art addressed itself to the problem of accelerating the flow of customers through the checkout stands in a self-service grocery store. (Findings of Fact 17, R. 524)

The Combination

Ray-O-Vac

The Anthony patent addressed itself to the problem existing at the time in the dry cell battery field and states the object which the inventor claims to attain by his device. To accomplish his object, Anthony used the ordinary, well-known dry cell and enclosed it within a leak-proof, swell-proof casing.

Turnham

In the Turnham patent, the problem in the retail grocery industry is discussed in detail and the objects of the invention are laid out with a view to solving the problems stated. To accomplish his objects, Turnham used the ordinary L-shaped checking counter found in self-service grocery stores, added to it an extension and a movable three-sided guided bottomless pusher frame in combination therewith. (Findings of Fact 18, R. 524)

The Facts

Ray-O-Vac

The District Judge made findings which have support in the evidence, to the following effect: "That the problem presented was old and no solution was attained prior to Anthony's invention."

Turnham

The problem mitigated by the Turnham invention was of long standing. Defendant and others experimented with different devices intended to accomplish the results of the Turnham invention. None was entirely satisfactory and today practically every chain self-serve store organization in the United States uses the Turnham device first installed in the Weingarten stores. Turnham's novel check-out counter was a valuable contribution to the efficiency of the self-serve type of merchandising. It

increased the efficiency of each checking-out counter at least 30%. It is a great time, space and personnel saver. (Findings of Fact 13 and 14, R. 523-24)

Commercial Success

Ray-O-Vac	Turnham
That the cell met with immediate commercial success due to the advantages of its construction and not to extensive advertising:	Without the aid of sales promotion or advertising, the novelty and efficiency of the Turnham invention spread throughout the trade and its principles as defined by claims 4, 5 and 6 of the Turnham patent in suit were widely adopted by many chains operating self-serve stores or "Supermarkets" and gained the approval of experts. (Findings of Fact 11, R. 523)

Governmental Endorsement

Ray-O-Vac	Turnham
That the leakproof flashlight cell advantages were recognized by the Army and other governmental agencies was demonstrated by reliable tests.	That the advantages of the counter pusher were recognized by the United States Department of Commerce in its publication "Domestic Commerce", (Plaintiff's Exhibit 20, R. 326A)

When the similarity of facts with respect to the *Ray-O-Vac* case is coupled with the recently expressed reluctancy of this court to disturb concurrent Findings of Fact, the question of invention should be settled in favor of the patentee Turnham.

On October 11, 1948, this Court granted a petition for a writ of certiorari and later heard argument and decided *Graver Tank and Mfg. Co., Inc., et al vs. Linde Air Products Co.*, 336 U. S. 271. In that case, at page 275, there appears:

> "A court of law, such as this Court is, rather than a court for the correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error." (Citing cases).

On March 28, 1949, this Court granted a petition for a writ of certiorari and later decided *Faulkner vs. Gibbs*, 338 U. S. 267, 70 S. Ct. 25. In that case at 338 U. S. 268, we find:

> "We will not disturb the concurrent findings upon the issues presented to us in the petition for certiorari. We are not persuaded that the findings are shown to be clearly erroneous."

5. State of Art Prior to Turnham.

On the subject of prior art, the District Court, in its opinion, stated (R. 519-20):

> "During the trial of this case and after examining all previous patents deemed as being at all similar to the patent before us — including the many advanced by defendant — we indicated that we could see no similarity between any of those patents and the one at bar. We are still of this opinion."

The Court of Appeals affirmed Findings of Fact 17 (R. 524):

> "17. There is no similarity between the prior art patents cited by the Patent Office or the defendant and the invention disclosed in the Turnham patent."

In petitioner's brief, page 17, reference is made to the disclosure of the Morsa patent (R. 482) as showing a "U-shaped rack for moving cans in and out of a boiling de-

vice", with this reference being followed by an allegation that the use of "U-shaped, bottomless frames for moving merchandise was not new", referring the court to R. 515-524 in alleged support thereof.

This court will take judicial notice of the fact that pool ball racks in common use are of rigid triangular construction and they are not "U-shaped". If pages 515 and 524 of the record are consulted no reference will be found to "U-shaped" as suggested by petitioner in its brief. Apparently petitioner considers that the following statements in the opinions below supports the conclusions stated:

(R. 515):

> "The bottomless tray is not novel, as note for example, the well known pool rack."

(R. 524):

> "Three-sided bottomless racks or trays had been used in racking pool balls prior to the Turnham invention."

The structure of the Morsa patent alleged by petitioner in its brief "for moving cans in and out of a boiling device" is *not* "U-shaped" as stated. It takes the form of a horizontal platform 7 having cables 8 secured at its four corners for raising and lowering the platform 7.

6. Well Known Pool Ball Rack Does Not Anticipate Patented Combination.

The District Court appeared to feel that the "well known pool rack" (R. 515) anticipated any alleged novelty broadly in a "bottomless rack". While this may be true in a broad sense, there is no real comparison between the conventional rigid triangular pool ball rack and the Turnham three-sided open-ended frame.

If an attempt were made to rack up a set of pool balls in the Turnham frame, the balls would all roll out the open end. While it might be possible to move a few groceries along a counter in a pool ball rack, such a rack could not be unloaded by a sliding movement along the counter in the opposite direction. It would be necessary to bodily lift the rack *vertically* to *unload*.

7. Varnum and Dickinson Patents do not Correct Deficiency in Conventional Pool Ball Rack.

Petitioner, in its brief, at page 16, contends:

> "One of the most pertinent patents is the patent to Varnum, * * *."

It might even be said that Judge Martin, in his dissenting opinion, was of a similar state of mind when he stated (R. 537):

> "Quite apparently Turnham derived the idea underlying his patent from a different field by utilizing a commonly known and long existent art, that of racking pool balls upon a pool table. In effect, he merely opened up the apex of an ordinary pool ball rack so that the legs of the triangle became parallel to each other and perpendicular to the base."

Varnum shows (R. 427) a pool ball rack which is normally held in a triangular shape by the tension of the springs 12 when the balls are in position. When the balls are removed, the whole frame collapses, as shown in Fig. 3 of the drawings. If this device were used on a checkout counter it would be in the collapsed form shown in Fig. 3 when the customer approached the counter.

To use the Varnum rack upon the Turnham counter extension, it would require the use of both hands of the customer to hold the sides 7 and 8 parallel to each other against the tension of the springs 12. Someone else would have to place the groceries within the rack and upon the counter extension. If the sides 7 and 8 were then released to the tension of the springs 12, the tendency would be to rack the groceries into a triangular shape as they are being moved from the extension of the counter to a position opposite the cashier. To unload the Varnum rack two hands would be required to open the sides 7 and 8 to clear the groceries as the rack is moved back upon the extension of the counter.

Any attempt to use the pool ball rack shown in the Dickinson patent (R. 430) upon the extension of the Turnham counter would be as equally farfetched as above pointed out with respect to the Varnum patent.

8. The Turnham Patent Passes the Test Stated in the Cuno Case.

In *Cuno Engineering Corporation vs. Automatic Devices Corp.*, (1941) 314 U. S. 84 at page 91, Mr. Justice Douglas stated:

> "That is to say, the new device, however, useful it may be, must reveal the flash of creative genius, not merely the skill of the calling. If it fails, it has not established the right to private grant in the public domain."

There is no doubt but that Turnham showed a "flash of creative genius" in solving the problem which had been confronting the industry for a period of seventeen years and which had been thoroughly studied by experts in the field with a view of expediting the passage of customers past a checking counter. The record below clearly shows that the petitioner, as well as the Kroger Grocery & Baking Company, had been actively engaged for a long period of time in attempting to devise some means for relieving the delay at the checkout counters. The petitioner makes no claim of originality and it is equally clear that the petitioner appropriated the Turnham invention. After trying many forms of devices the Kroger Company ultimately adopted the Turnham invention several years after it was installed in the Weingarten Markets in Houston, Texas, and under conditions which offered every opportunity for knowledge of the Turnham device (R. 513).

The fact that Turnham, when hard pressed by the management of the Weingarten Markets, came forward within a short period with the first real attempt to solve or mitigate the problem is indicative that he, in fact, had a flash of creative genius.

9. There was no Error in Allowing Respondent to Withdraw Claims 1, 2 and 3 and Rely Upon Claims 4, 5 and 6 Stipulated Before Trial as Infringed, if Valid, and Allowing Costs to Respondent.

The prior art cited by petitioner does not invalidate claims 1, 2 and 3, nor have they been held invalid. Thus,

no obligation to disclaim arose, *Ensten vs. Simon, Ascher & Company*, 282 U. S. 445. In *France Mfg. Co. vs. Jefferson Electric Co.*, (C. C. A. 6, 1939) 106 Fed. 2d. 605 at 611, Circuit Judge Hamilton stated:

> "The trial court refused the request of counsel for appellant to rule on the validity of the claims of the patent not declared. A consideration of the evidence makes applicable the rule that an inspection of the patent by the patentees or their assignee would not have disclosed they had claimed more than they had invented or described. They had the right to rely on the presumption of the validity of their claims granted by the patent office until a court of competent jurisdiction decided that their claim or claims were broader than their real invention. Ensten v. Simon, Ascher & Company, 282 U. S. 445, 458, 51 S. Ct. 207, 75 L. Ed. 453; General Chemical Company vs. Standard Wholesale Phosphate & Acid Works, Inc. 4 Cir., 77 F. 2d. 230."

As to the allowance of costs to respondent the case of *Gamewell Fire-Alarm Telegraph Co. et al vs. Municipal Signal Co. et al.* (C. C. A. 1, 1896) 77 F. 490, is directly in point wherein it was held:

> "The record shows that the suit was on letters patent containing three or more claims, and that the bill of complaint charged generally infringement, but that it in no particular indicated what special claims were infringed. The answer was equally general in its denials. It also, in general terms and without any specification, averred that a disclaimer was necessary. As the cause proceeded, the complainants limited their issues to claim 1 of the patent. No other claim was submitted to the judgment of the court, or passed on by it. Under these circumstances, had the circuit court the duty to withhold the complainants' costs, because the complainants had not disclaimed as provided in the statutory provisions referred to? We think not. There was nothing on record to show that any claims in the patent needed to be disclaimed within the purview of those provisions, and the court had

not been asked to pass on any claims except the first one, even if it could have been required to do so merely for a matter of costs. Under these circumstances, we are governed by Fabrics Co. v. Smith, 100 U. S. 110, as applied in Paper-Bag cases, 105 U. S. 766, 770, 772, and appearing in all essential particulars, including the issue of an injunction, like the case at bar. The general rule is also well stated in Mills v. Green, 159 U. S. 651, 653, 16 Sup. Ct. 132."

Both of the lower courts relied on the case of *Ford Motor Co. vs. Gordon Form Lathe Co.*, (C. C. A. 6, 1937) 90 Fed. 2d. 999 (R. 521, 536) in support of the right on the part of the District Court, and within its discretion, to permit that which was, in effect, an amendment to the pleadings. As the matter was within the court's discretion, whether or not the defendant objected to the withdrawal of the claims from the consideration of the court is of no consequence.

CONCLUSION

The Turnham invention provided the self-serve food market operators with an improvement, mitigating for the first time a fundamental problem which had plagued the self-serve market since its conception in 1917. It satisfies, to a substantial degree, an admitted long felt want and it was immediately adopted by the experts. That the invention was not obvious clearly appears from the record before the District Court and this Court.

There is nothing to suggest that the simple combination of elements proposed for the first time by Turnham would result in an increase of the efficiency of more than thirty per cent. This unexpected result is further evidence of invention.

Turnham's invention was the first to provide the cashier or checker with any degree of assistance in checking out the customer. Millions of people every day are receiving the benefits of this invention by being relieved of a substantial amount of the annoying delay previously experienced.

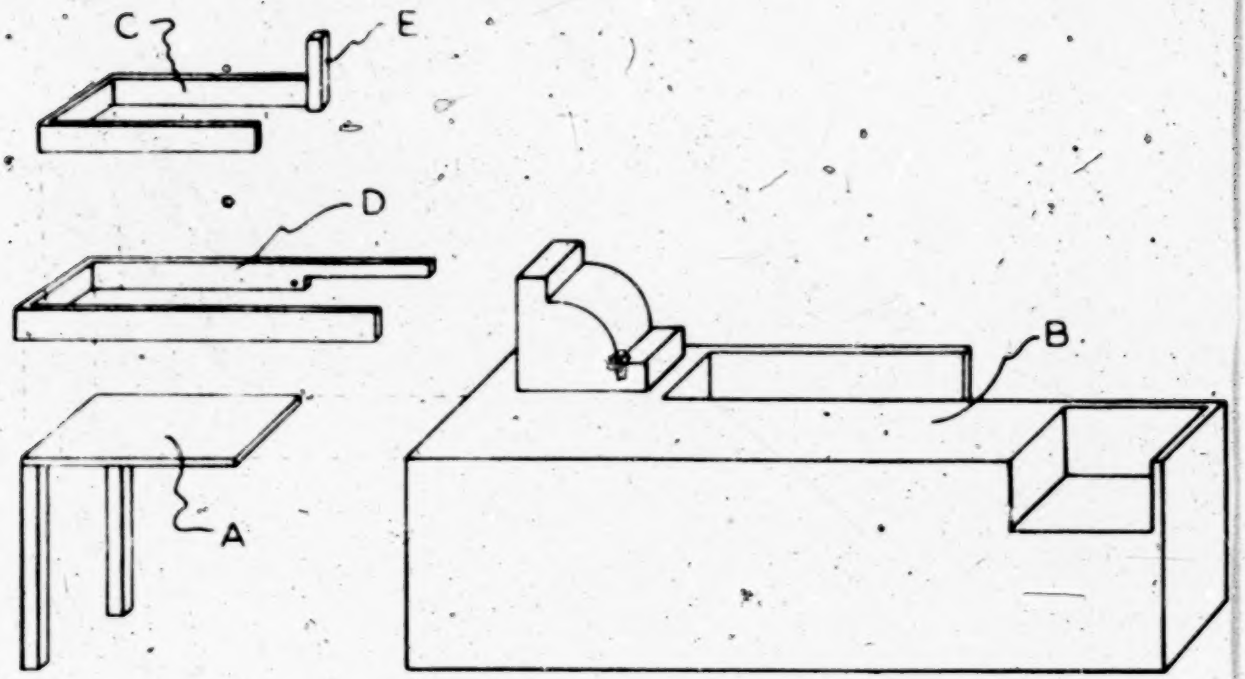
Infringement of claims 4, 5 and 6 is admitted by the stipulation of petitioner. The carefully considered judgment of the District Court, affirmed by the Court of Appeals for the Sixth Circuit, should be sustained.

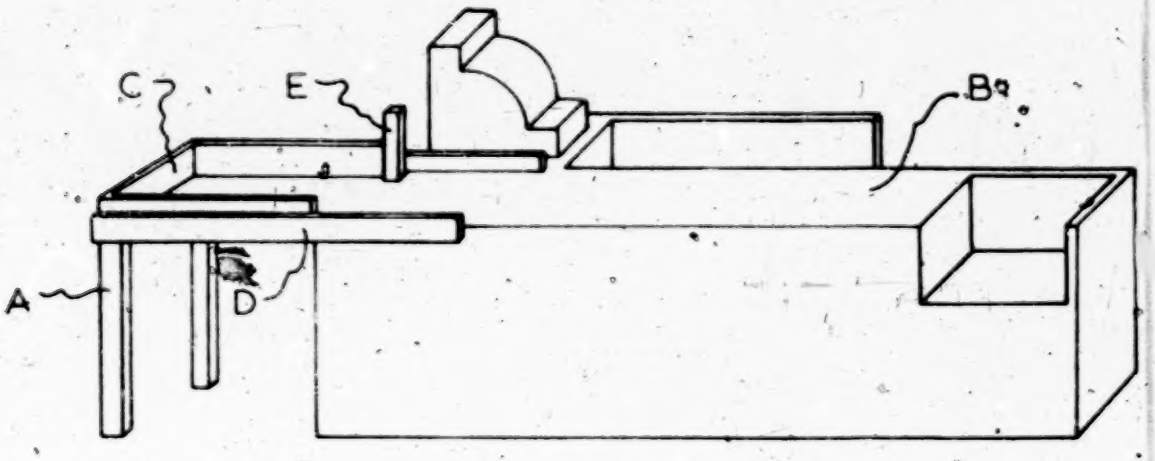
Respectfully submitted,

TOWNSEND F. BEAMAN,
Attorney for Respondent.

LLOYD W. PATCH,
Of Counsel.

APPENDIX





6. A cashier's counter for cash and carry type of grocery comprising a portion (A) spaced from the cashier's stand (B) and upon which the merchandise may be deposited and arranged, a bottomless frame (C) on said portion (A) and within which the merchandise is deposited and arranged, means (D & E) whereby said frame (C) is movable on said counter from said portion (A) to a position adjacent the cashier's stand (B) so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier, said frame (C) being open at the end adjacent the cashier's stand (B) and readily movable to be returned over said portion (A) so as to receive the merchandise of another customer while the cashier is occupied with the previous group.